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09/788,339	02/21/2001	Sadaji Tsuge	TOR.011.0001.NP	1063
58789	7590	03/02/2009	EXAMINER	
NDQ&M WATCHSTONE LLP 1300 EYE STREET, NW SUITE 1000 WEST TOWER WASHINGTON, DC 20005				BARTON, JEFFREY THOMAS
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SADAJI TSUGE

Application No. 09/788,339
Technology Center 1700

Mailed: March 2, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal.*

BENNETT, *Review Team Paralegal.*

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on February 10, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, ARGUMENTS

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed July 15, 2008 under the heading “Argument” have not been clearly provided. Each grounds of rejection must be treated under a **separate heading** in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellant has not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007)* for details.

EXAMINER’S ANSWER, MISSING CERTIFIED TRANSLATION

The Examiner relied on the foreign reference JP 11-307791 in rejecting the claims. A full certified English translation of the above-noted foreign reference is not of record in the Image File Wrapper (IFW).¹

When an Examiner relies on a document “in a language other than English, a translation *must* be obtained so that the record is clear as to the

¹ It is noted that a Japanese Abstract and a computer-generated translation were included with the Final Rejection mailed August 21, 2003. However, the first page of the translation states that the “document has been translated by computer. So the translation may not reflect the original precisely.”

precise facts the examiner is relying upon in support of the rejection” (emphasis added). MPEP §1207.02. Pursuant to a memorandum dated April 29, 2002 by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy:

Effective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: (1) a rejection is supported in whole or part by an abstract without reference to the underlying document, . . . ; or (2) a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English.

The memorandum also states “[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection” (emphasis added).

CONCLUSION

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on July 15, 2008 defective;
- 2) to notify Appellant to file a paper properly presenting the arguments for each grounds of rejection as required;
- 3) to obtain a full certified English language translation of the above-noted foreign reference (JP 11-307791);

- 4) to complete the IFW by having the translation obtained scanned into the IFW file;
- 5) to provide a copy of the translation obtained to Appellant; and
- 6) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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